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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,085	10/12/2001	Jonathan I. McCormack	TVW/APP33US	1923
59906	7590	01/12/2009	EXAMINER	
Saul Ewing, LLP			WON, MICHAEL YOUNG	
TVWORKS, LLC			ART UNIT	PAPER NUMBER
1500 MARKET STREET				2455
38th Floor				
PHILADELPHIA, PA 19102				
MAIL DATE		DELIVERY MODE		
01/12/2009		PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JONATHAN I. McCORMACK, VENKATACHARY
SRINIVASAN, HARI VASUDEV, and RAYMOND DREWERY

Appeal 2008-2926
Application 09/977,085¹
Technology Center 2100

Decided: January 9, 2009

Before JEAN R. HOMERE, ST. JOHN COURTEMAY III,
and CAROLYN D. THOMAS, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 15 through 27. Claims 1 through 14 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ Filed on October 12, 2001. The real party in interest is TVWORKS, LLC.

The Invention

As shown in Figure 1, Appellants invented a portable digital identity server (100) coupled to a digital identity database (118) and a command server (120) via the Internet (114) to permit a user operating a user device (102-112) to access familiar and authorized services across different platforms. (Spec. 5.) Particularly, as depicted in Figure 2, upon the user entering unique identifying information (e.g. e-mail, password) into the user device (204, 206), the entered information is sent to the digital identity server via an adapter (224, 226) corresponding to the requesting user device (204, 206). (Spec. 7-8.) The entered information is then used to access digital identity for the requesting device from the database (236), as well as to access configuration information about the requesting device from the command server (238). The retrieved configuration information is subsequently used to filter the retrieved digital identity information, and to provide filtered digital identity to the requesting user device (Spec. 9.)

Independent claim 15 further illustrates the invention. It reads as follows:

15. A system, comprising:

a database for storing a digital identity for each of at least two user devices and providing access to the digital identities, wherein one of the user devices is a DTV client;

a command server for storing a plurality of configuration information about each user device and providing access to the configuration information; and

a digital identity server coupled to the database and the command server and including at least two adapters for at least two types of user device, each adapter associated with one of the types of user devices, the adapters for storing a plurality of digital identity data associated with each digital identity, providing access to the digital identity data, and interfacing with each user device, the digital identity server configured for receiving a request from a particular user device via one of the adapters, accessing the digital identity for the particular user device from the database, accessing the configuration information about the particular user device from the command server, applying the configuration information to filter the digital identity, and providing the filtered digital identity to that user device via one of the adapters.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Jindal	US 6,092,178	Jul. 18, 2000
Desrochers	US 6,553,405 B1	Apr. 22, 2003 (filed Feb. 25, 2000)
Kessler	US 6,621,528 B1	Sep. 16, 2003 (filed May 22, 2000)
Jiang	US 6,741,853 B1	May 25, 2004 (filed Nov. 9, 2000)

Rejections on Appeal

The Examiner rejects the claims on appeal as follows:

A. Claims 15 through 19 and 23 through 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Jiang and Kessler.

B. Claims 20 through 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Jiang, Kessler, and Desrochers.

C. Claims 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Jiang, Kessler, and Jindal.

Appellants' Contentions

Appellants argue that the combination of Jiang and Kessler does not render independent claim 15 unpatentable. (App. Br. 10-14.) Particularly, Appellants argue that the combination of Jiang and Kessler does not teach or suggest a database for storing digital identity for a digital television (DTV). Appellants recognize that Jiang teaches storing user authentication information (e.g. username, addresses, password). Appellants argue, however, that such information does not suggest the claimed digital identity, which includes e-mail, TV, credit card preferences, and shipping information. (App. Br. 11-12.) Further, Appellants argue that one of ordinary skill in the art would not have found sufficient rationale to modify Jiang's system for providing voicemail and electronic mail services to include therein Kessler's DTV control system. (App. Br. 10-11.) Thus, Appellants conclude that there is no reasonable expectation of success in the combination proffered by the Examiner. (*Id.*)

Examiner's Findings/Conclusions

The Examiner finds that Jiang's disclosure of a wireless portal middleware (WPM) that maintains a plurality of profiles including service

profile, preference profile, device profile, and service profile teaches the claimed digital identity as recited in independent claim 15. (Ans. 14.) Similarly, the Examiner finds that Jiang's disclosure of an optional database in the WPM that stores the portable devices, and their respective capabilities teaches the claimed database. (Ans. 5.) Further, the Examiner recognizes that Jiang's disclosure does not particularly recite a DTV as being one of the portable devices attached to the WPM. However, the Examiner finds Jiang's WPM to be a scaleable portal that would be able to support Kessler's DTV since digital cellular phone technology, at the time of the invention, provided support for downloading music and movies. (Ans. 12-13.) Therefore, the Examiner concludes that the ordinarily skilled artisan would know how to properly combine Jiang's digital cellular technology with Kellser's DTV to render claim 15 unpatentable. (*Id.*)

II. ISSUE

The pivotal issue before us is whether Appellants have shown that the Examiner erred in concluding that the combination of Jiang and Kessler renders the claimed invention unpatentable. Particularly, the issue turns on whether the ordinarily skilled artisan would have found sufficient rationale to combine the cited references to teach a database that stores digital identity for at least two user devices, one of which being a DTV client as recited in independent claim 15.

III. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Jiang

1. Jiang discloses a wireless portal middleware (WPM) that seamlessly integrates wireless devices to deliver the requested information to each device in a suitable format. (Col. 5, ll. 38-41.)
 - 2a. As depicted in Figure 2, the WPM (210) provides a single portal through which wireless users can communicate with a desired Internet content provider (ICP) (250-260). (Col. 6, ll. 45-50.)
 - 2b. The WPM (210) is a programmable platform for implementing telecommunication services (e.g. voice mail, e-mail personal information management, and Internet access services. (Col. 6, ll. 51-55.)
 - 2c. The WPM (210) is also a scaleable platform that allows valued added services to be added without software or hardware restructuring. It provides an open interface to wireless and wireline networks to support evolving technologies, and service offerings. (Col. 6, ll. 55-60.)
 - 2d. The WPM (210) provides users of wireless devices (e.g. cell phone, mini-browser phone, laptop computer, PDA, etc.) seamless access to information networks by maintaining a central repository for subscriber information and services. (Col. 7, ll. 12-16.)

2e. The WPM (210) also maintains multiple profile schemas including user profile, service profile, preference profile, device profile, usage profile, and logon profile. (Col. 11, l. 33- col. 12, l. 5.)

3a. As shown in Figure 7, the WPM (716) contains a portal (730) including two access points (742, 754), each being connected to a respective wireless device (718, 720). (Col. 8, ll. 37-42.)

3b. The WPM (716) also contains a portable middleware server (PMS-732), which recognizes the different wireless devices. It acquires information to convert them between different protocols and formats to organize personalized configurations and content of a user's session. (Col. 8, ll. 46-62.)

3c. The WPM optionally maintains a database of possible devices, and their capabilities. (Col. 18, ll. 7-13.)

Kessler

4. Kessler discloses a user module (108) equipped with a mechanism for auto-programming and tuning a digital television. (Col. 3, ll. 53-67.)

IV. PRINCIPLES OF LAW

Claim Construction

"[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d at 1312 (internal citations omitted). "[T]he ordinary and customary meaning of a claim term

is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d at 1323.

Obviousness

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," and discussed circumstances in which a patent might be determined to be obvious. *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the

art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 127 S. Ct. at 1740-41).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Kahn*, 441 F.3d at 987-988 (Fed. Cir. 2006), *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991) and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826 (CCPA 1968).

V. ANALYSIS

Independent claim 15 recites in relevant part a database for storing digital identity for a DTV client. As set forth in the Findings of Facts section, Jiang discloses a WPM that has a central repository for subscribers and devices to thereby provide users seamless access to information networks regardless of the type of devices that are being used. (FF. 2d.) Particularly, the WPM maintains a database having multiple profile schemas including user preferences, device preferences, service preferences. (FF. 2e, 3c.) We agree with the Examiner that Jiang's central repository or optional

database teaches the claimed database for storing digital identity for a wireless user device. We have reasonably but broadly construed the claimed digital data, consistently with Appellants' Specification, to include preference data pertaining to the user device. Still, we find that Jiang's storage of device preferences and service preferences teaches storing the claimed digital identity for a wireless user device. While Jiang does not particularly disclose the user device to be a DTV, it suggests that the WPM would provide seamless access to information without regard to the type of device available to the user. In other words, the ordinarily skilled artisan would readily appreciate that regardless of the type of device available to the user, the WPM's database or repository would still store digital entity or preference data for whatever device that it identifies. As evidenced by Kessler's disclosure, at the time of the invention, DTV was available to be used as a user device. (FF. 4.) Therefore, we agree with the Examiner that it would not have been unreasonable for the skilled artisan to use Kessler's DTV as a user device in Jiang's scaleable WPM. We therefore conclude that the ordinarily skilled artisan would have readily appreciated that Jiang and Kessler disclose prior art elements that perform their ordinary functions to predictably result in a WPM having a database that stores preference information for a DTV. We therefore do not agree with Appellants that the combination of Jiang and Kessler is improper. For these same reasons, we do not agree with Appellants that there is no reasonable expectation of success in combining these references. It follows that Appellants have not

shown that the Examiner erred in concluding that the combination of Jiang and Kessler renders independent claim 15 unpatentable.

Appellants did not provide separate arguments with respect to the rejection of claims 16 through 19 and 23 through 25. Consequently, these claims fall together with representative claim 15. 37 C.F.R. § 41.37(c)(1)(vii).

Next, Appellants argue that neither Desrochers nor Jindal cures the deficiencies of the Jiang and Kessler combination. Therefore, Appellants argue that the Examiner's rejection of claims 20 through 22, 26, and 27 is improper. (App. Br. 13-14.) As discussed above, we find no such deficiencies in the Jiang-Kessler combination for the cited tertiary references to cure. Therefore, Appellants have not shown that the Examiner erred in concluding that the combination of Jiang and Kessler, taken with either Desrochers or Jindal renders claims 20 through 22, 26, and 27 unpatentable.

VI. CONCLUSIONS OF LAW

Appellants have not shown that the Examiner erred in concluding that the combination of:

1. Jiang and Kessler renders claims 15 through 19 and 23 through 25 unpatentable under 35 U.S.C. § 103(a).
2. Jiang, Kessler, and Desrochers renders claims 20 through 22 unpatentable under 35 U.S.C. § 103(a).

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3. Jiang, Kessler, and Jindal renders claims 26 and 27 unpatentable under 35 U.S.C. § 103(a).

VII. DECISION

We affirm the Examiner's decision to reject claims 15 through 27. No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

rwk

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